

REMARKS

Claims 1-98 are pending. Claims 1, 9, 17, 26, 38, 47, 55, 63, 72, 84, 93, and 96 have been amended to more clearly recite the invention. No new matter has been added.

The Office Action indicates that a Notice of References Cited (PTO-892) was included. However, the PTO-892 form was not received. The Examiner is requested to include a copy of the previous Notice of References Cited (PTO-892) in the next office communication.

Claims 1, 2, 4-6, 8-10, 12-14, 16-20, 22-32, 34-39, 41, 43-48, 50-52, 54-60, 62-66, 68-78, 80-85, 87, and 89-98 were rejected under 35 U.S.C. 102(e) as being anticipated by Zamora-McKelvy (US Patent No 6,519,616). This rejection is respectfully traversed.

Claim 1, 9, 26, 38, 47, 55, 72, 84, 93, 96 recite “genealogical information.” Zamora-McKelvy fails to teach or disclose “genealogical information.”

The Office Action asserts that “genealogical information” in the query is “any kind of name or dates in the query” (see e.g., Office Action, pages 2, 6 or 7). Thus, the Office Action attempts to ignore the term “genealogical” in the claim and concludes that the “genealogical information” is “any kind” of information. However, it is improper to ignore the term “genealogical” because “[A]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*. 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Office Action’s assertion is incorrect and is contrary to the meaning of the term “genealogical” as understood by those of skill in the art. For example, the Merriam-Webster online dictionary defines “genealogical” as “1) an account of the descent of a

person, family, or group from an ancestor or from older forms, 2) regular descent of a person, family, or group of organisms from a progenitor or older form, or 3) the study of family pedigrees. As an example of the Zamora-McKelvy system, if a user requests a directory listing for “Joe’s Diner”, Zamora-McKelvy will provide a directory listing of “Joe’s Diner”. This is clearly not “genealogical information” and it is unclear why the Office Action asserts that it is.

Zamora-McKelvy discloses a web site in which a user may search for a company using as a search term the company’s name, address, telephone number and hyperlink to the company’s web page (col. 4, lines 10-13, 18-20). Clearly neither the company’s name, address, telephone number, nor hyperlink constitutes “genealogical information” of the company. However, to expedite prosecution, claims 1, 9, 26, 38, 47, 55, 72, 84, 93, and 96 have been amended to more clearly recite that the information is not merely “any kind” of information as the Examiner contends but comprises “genealogical information.” Thus, the rejection should be withdrawn.

Claims 17 and 63 recite, that the first and second records contain chronologically different information. The Office Action cites col. 3, lines 7-31 of Zamora-McKelvy to provide this teaching. However, upon examination of col. 3, lines 7-31 of Zamora-McKelvy, no reference to a first and second record containing chronologically different information is found. Indeed, Zamora-McKelvy does not teach or suggest a first and second record containing chronologically different information at all.

Claims 17 and 63, as amended, recite that a query result includes at least one indicator for each of the first record and the second record corresponding to query information. Zamora-McKelvy merely discloses providing search results of names of

companies matching a user's search inquiry but fails to teach or suggest at least one indicator for each of a first and a second record wherein the first and second record contain chronologically different information. Therefore, the rejection should be withdrawn.

Claims 2, 4-6, 8, 10, 12-14, 16, 18-20, 22-32, 34-37, 39, 41, 43-46, 48, 50-52, 54-60, 62, 64-66, 68-71, 73-78, 80-83, 85, 87, 89-95, 97 and 98 depend from claims 1, 9, 17, 26, 38, 47, 55, 63, 72, 84, 93, or 96 and are allowable for at least the reasons set forth above.

Claims 3, 11, 21, 33, 42, 49, 57, 67, 79, and 88 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zamora-McKelvy in view of Waites (US Pat No. 6,788,769). This rejection is respectfully traversed.

Claims 3, 11, 21, 33, 42, 49, 57, 67, 79, and 88 depend from claims 1, 9, 17, 26, 38, 47, 55, 63, 72, and 84, respectively. As set forth above, Zamora-McKelvy fails to teach or suggest the claims 1, 9, 17, 26, 38, 47, 55, 63, 72, and 84. Waites fails to cure the deficiencies of Zamora-McKelvy. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Zamora-McKelvy discloses a directory service for searching for information on a company and Waites discloses an Internet directory service. However, neither Zamora-McKelvy nor Waites teaches or suggests "genealogical information." To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Neither Zamora-McKelvy nor Waites, either alone or in combination, teach or suggest all

claim limitations (e.g., “genealogical information”). Therefore, the rejection should be withdrawn.

Claims 7, 15, 40, 53, 61, and 86 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zamora-McKelvy in view of Waites and further in view of McAllister (US Pat No. 6,421,672). This rejection is respectfully traversed.

Claims 7, 15, 40, 53, 61, and 86 depend from claims 1, 9, 38, 47, 55, and 84, respectively. As set forth above, neither Zamora-McKelvy nor Waites, either alone or in combination, teach or suggest claims 7, 15, 40, 53, 61, and 86. McAllister does not cure the deficiencies of Zamora-McKelvy and/or Waites.

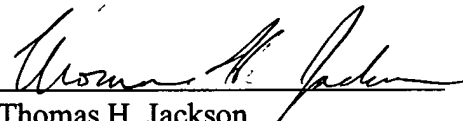
The Office Action asserts that McAllister discloses “secondary information” in Fig. 5; Fig. 4, step 114; and col. 9, line 55- col. 10, line 67 and concludes that the “secondary information” of McAllister is equivalent to “genealogical information” and is further equivalent to “one of a parent’s name and a sibling’s name.” (See Office Action, page 16). However, col. 9, line 55-col. 10, line 67 of McAllister merely discloses the secondary information as a “listing by telephone number” (col. 10, line 11), a “location or department of a particular party” (col. 10, lines 19 and 34), or a city in which the party lives (col. 10, lines 40-41). However, nowhere does McAllister disclose “genealogical information” as the term “genealogical information” is understood by those of skill in the art. Nor does McAllister disclose “one of a parent’s name and a sibling’s name.” The Office Action attempts to ignore the term “genealogical” to conclude that any information at all constitutes “genealogical information.” This is improper. Moreover, the Office Action attempts to equate location information and telephone information with “one of a parent’s name and a sibling’s name.” Clearly, location, city or telephone information is

not equivalent to either a parent's name or a sibling's name. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*. 424 F.2d 1382,1385, 165 USPQ 494, 496 (CCPA 1970). Thus, the rejection should be withdrawn.

Applicants respectfully submit that the instant application is in condition for allowance. Application respectfully requests that a timely Notice of Allowance be issued in this case.

If the Examiner feels, however, that further amendment and/or discussion may be helpful in facilitating prosecution of the case, the Examiner is respectfully requested to telephone the undersigned attorney of record at the number appearing below.

Respectfully submitted,


Thomas H. Jackson
Registration No. 29,808

BANNER & WITCOFF, LTD.
1001 G Street, N.W.
Washington, D.C. 20001
(202) 824-3000

Date: December 30, 2004